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Docket C041473/0124196

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ross A. Caputo *et al.*) Examiner: Monzer R. Chorbaji
Serial No.: 09/901,389) Art Unit: 1744
Filed: July 9, 2001)
For: **APPARATUS FOR TESTING**)
STERILIZATION METHODS AND)
MATERIALS)

March 6, 2006

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 CFR § 1.705(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request For Reconsideration Of Patent Term Adjustment Under 37 CFR § 1.705 (b) ("Request") is being filed in response to the Notice of Allowance and Fee(s) Due ("Notice") and Notice of Allowability mailed February 8, 2006. The Determination of Patent Term Adjustment Under 35 USC § 154(b) mailed with those papers indicates the adjustment is only for **813 days**. We respectfully submit that applicants' patent will be entitled to an adjustment of **841 days** – a difference of 28 days.

This Request is being filed before payment of the issue fee and is therefore timely. 37 CFR § 1.705(b).

03/13/2006 TBESHAN2 00000102 09901389

01 FC:1455

200.00 OP

RS1297507.1

We enclose a check for \$200.00 to cover the applicable fee. 37 CFR §§ 1.705(b)(1) and 1.18(e). Please charge any required fees not otherwise paid by check to Deposit Account No. 02-4467. A copy of this paper is enclosed.

The facts underlying this request are simple:

- The patent application was filed July 9, 2001.
- An Office Action was mailed March 23, 2005 to the **wrong** address.¹

The Office Action was re-mailed April 7, 2005 to the **correct** address and the three-month shortened statutory period for response **re-started**. A difference of 14 days.

- A Response to Office Action with a properly executed certificate of mailing ("Response") and a one-month extension of time was timely mailed on July 28, 2005 in response to the April 7, 2005 Office Action. The PTO received the Response on August 1, 2005. Exhibit 3 attached hereto is a copy of the date-stamped postcard evidencing such receipt.
- A Sixth Supplemental Information Disclosure Statement was mailed October 11, 2005, and the PTO received it October 14, 2005. Exhibit 4 attached hereto is a copy of the date-stamped postcard evidencing such receipt.
- The next paper received from the PTO was a Final Office Action mailed October 19, 2005.

¹ A Change of Correspondence Address Form was filed for the above-referenced application on June 25, 2003, almost two years earlier. A copy of that Form is attached (Exhibit 1 hereto), as is a copy of the PTO-stamped postcard acknowledging receipt of that Form (Exhibit 2 hereto).

We enclose a check for \$200.00 to cover the applicable fee. 37 CFR §§ 1.705(b)(1) and 1.18(e). Please charge any required fees not otherwise paid by check to Deposit Account No. 02-4467. A copy of this paper is enclosed.

The facts underlying this request are simple:

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- A Response to Office Action with a properly executed certificate of mailing ("Response") and a one-month extension of time was timely mailed on July 28, 2005 in response to the April 7, 2005 Office Action. The PTO received the Response on August 1, 2005. Exhibit 3 attached hereto is a copy of the date-stamped postcard evidencing such receipt.
- A Sixth Supplemental Information Disclosure Statement was mailed October 11, 2005, and the PTO received it October 14, 2005. Exhibit 4 attached hereto is a copy of the date-stamped postcard evidencing such receipt.
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¹ A Change of Correspondence Address Form was filed for the above-referenced application on June 25, 2003, almost two years earlier. A copy of that Form is attached (Exhibit 1 hereto), as is a copy of the PTO-stamped postcard acknowledging receipt of that Form (Exhibit 2 hereto).

- A Response to Final Office Action with a properly executed certificate of mailing ("Response to Final") was timely mailed on January 12, 2006 in response to the October 19, 2005 Final Office Action. The PTO received the Response to Final on January 17, 2006. Exhibit 5 attached hereto is a copy of the date-stamped postcard evidencing such receipt.
- The next papers received from the PTO were the Notice of Allowance and Fee(s) Due, Notice of Allowability, etc. mailed by the PTO on February 8, 2006 (copy of the first page of the Notice of Allowance is attached hereto as Exhibit 6).

Based on the foregoing, applicants are entitled to a patent term adjustment of **841** days under 37 CFR §§ 1.702(a)(1), 1.703(a)(1), 1.704(b), and 1.704(c)(8) because (a) the PTO failed to mail an Office Action within fourteen months of the application's filing date (i.e., it failed to mail a responsive paper on or before September 9, 2002 to the correct address) and (b) the PTO erred in calculating the patent term adjustment (i.e., it failed to calculate the patent term adjustment from the April 7, 2005 Office Action - the Office Action mailed to the **correct** address - but instead in their calculations used the March 23, 2005 Office Action mailed to the **wrong** address, which was corrected by the mailing of the April 7, 2005 Office Action to the correct address).

The requested adjustment of **841** days is calculated according to the formulas set forth in 37 CFR § 1.703 (a)(1) and §§1.704(b) and (c)(8) :

§ 703(a) _____ - 940 days September 10, 2002 (the day after the date that is fourteen months after the date the application was filed under 35 USC § 111(a)) to April 7, 2005 (the date of mailing of the Office Action to the correct address), **not** March 23, 2005 (the date of mailing of the Office Action to the wrong address).

§ 704(b) _____ - 25 days July 8, 2005 – August 1, 2005 (reduced by the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection (i.e., July 8, 2005, **not** June 24, 2005) and ending on the date the reply was filed (i.e., August 1, 2005)).

§ 704(c)(8) _____ - 74 days August 2, 2005 – October 14, 2005 (Submission of a supplemental reply or other paper (i.e., the Sixth Supplemental Information Disclosure Statement) after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed (i.e., August 2, 2005) and ending on the date that the supplemental reply or other such paper was filed (i.e., October 14, 2005)).

Total adjustment = 940 days - (25 days + 74 days) = 841 days
(assuming the patent issues within the prescribed time).

As shown by our calculations, the term for the allowed patent should be 841 days, not just 813 days.

Upon information and belief, the undersigned represents that the patent to issue based on the above-identified application will not be subject to a terminal disclaimer (37 CFR § 1.705 (b)(2)(iii)).

For the foregoing reasons, applicants respectfully request that 841 days be added to the term of the patent (instead of 813 days).

Please contact the undersigned if there are any questions regarding this paper.

I hereby certify that this correspondence (including the check and other papers identified as being enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-14501, on March 6, 2006.

Charles M. Avigliano

Respectfully submitted,

By: Stephen P. Gilbert

Stephen P. Gilbert
Registration No. 27,893
Charles M. Avigliano
Registration No. 52,578
BRYAN CAVE LLP
1290 Avenue of Americas
New York, NY 10104-3300
(212) 541-2000

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**CHANGE OF
CORRESPONDENCE ADDRESS
Application**Address to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

Application Number	09/901,389
Filing Date	July 9, 2001
First Named Inventor	Ross A. Caputo
Art Unit	1764
Examiner Name	To be Assigned
Attorney Docket Number	41473/124196

Please change the Correspondence Address for the above-identified patent to:

☐ Customer Number

Type Customer Number here

Place Customer
Number Bar Code
Label here

OR

<input checked="" type="checkbox"/> Firm or Individual Name	BRYAN CAVE LLP				
Address	1290 AVENUE OF THE AMERICAS, 33RD FLOOR				
Address					
City	NEW YORK	State	NEW YORK	Zip	10104
Country	U.S.A.				
Telephone	(212) 541-2000	Fax	(212) 541-4630		

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the:

- ☐ Applicant/Inventor
- ☐ Assignee of record of the entire interest.
Statement under 37 CFR 3.7(b) is enclosed. (Form PTO/SB/96).
- ☒ Attorney or Agent of record.
- ☐ Registered practitioner named in the application transmittal letter in an application without an executed oath or declaration: See 37 CFR 1.33(a)(1). Registration Number _____

Typed or Printed Name	STEPHEN P. GILBERT, REG. NO. 27,893	
Signature	<i>Stephen P. Gilbert</i>	
Date	June 18, 2003	Telephone (212) 541-2000

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

June 25, 2003

Docket No.: (C41473/124196)

In re Application of:

Ross A. CAPUTO, Robert R. REICH, Jr., Robert J. THRASH, Jimmy FISHER, Davoud KHORZAD, and Thomas F. CULLEN

Serial No. 09/901,389

Filed: July 9, 2001

For: **APPARATUS FOR TESTING STERILIZATION METHODS AND MATERIALS**

Enclosed:

1. Third Supplemental Information Disclosure Statement (3 pp. with Certificate of Mailing, in duplicate);
2. Form PTO-1449 (1 pg, in duplicate);
3. Copies of documents cited on Form PTO-1449;
4. Change of Correspondence Address (1 pg); and
5. Return postcard.

**PLEASE DATE STAMP & RETURN TO
ACKNOWLEDGE RECEIPT**

SPG/Z15

June 25, 2003

Docket No.: (C41473/124196)

In re Application of:

Ross A. CAPUTO, Robert R. REICH, Jr., Robert J. THRASH, Jimmy FISHER, Davoud KHORZAD, and Thomas F. CULLEN

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5. Return postcard.

**PLEASE DATE STAMP & RETURN TO
ACKNOWLEDGE RECEIPT**

SPG/Z15



July 28, 2005

Docket No: C041473/0124196

In re Application of: Ross A. Caputo *et al.*

Serial No. 09/901,389

Filed: July 9, 2001

For: APPARATUS FOR TESTING STERILIZATION METHODS AND MATERIALS

Enclosed:

1. Response to April 7, 2005 Office Action Including Amendment and Extension of Time (62 pp., including duplicate page 2);
2. Check in the amount of \$60.00 to cover extension fee (small entity for one month);
3. Check in the amount of \$450.00 to cover the fee for extra dependent claims (48-56); and
4. Return postcard.

KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT

CMA:rb

July 28, 2005

Docket No: C041473/0124196 ✓

In re Application of: Ross A. Caputo *et al.*

Serial No. 09/901,389

Filed: July 9, 2001

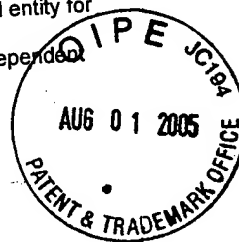
For: APPARATUS FOR TESTING STERILIZATION METHODS AND MATERIALS

Enclosed:

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4. Return postcard.

KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT

CMA:srb



October 11, 2005

Docket No: C041473/0124196

In re Application of: Ross A. Caputo *et al.*
Serial No. 09/901,389

Filed: July 9, 2001

For: APPARATUS FOR TESTING STERILIZATION METHODS AND
MATERIALS

Enclosed:

1. Sixth Supplemental Information Disclosure Statement with Certificate of Mailing (4 pp., including duplicate page 3);
2. Form PTO-1449 (1 page in duplicate); and
3. Return postcard.

**KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT**

CMA:srb

October 11, 2005

Docket No: C041473/0124196

In re Application of: Ross A. Caputo *et al.*
Serial No. 09/901,389

Filed: July 9, 2001

For: APPARATUS FOR TESTING STERILIZATION METHODS AND
MATERIALS

Enclosed:

1. Sixth Supplemental Information Disclosure Statement with Certificate of Mailing (4 pp., including duplicate page 3);
2. Form PTO-1449 (1 page in duplicate); and
3. Return postcard.

**KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT**

CMA:srb



January 12, 2006

Docket No: C041473/0124196

In re Application of: Ross A. Caputo *et al.*
Serial No. 09/901,389

Filed: July 9, 2001

For: APPARATUS FOR TESTING STERILIZATION METHODS AND
MATERIALS

Enclosed:

1. Response to Office Action Under 37 CFR § 1.116 Including Amendment with Certificate of Mailing (22 pp. including duplicate page 2); and
2. Return postcard.

KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT.

CMA:srb

January 12, 2006

Docket No: C041473/0124196 ✓

In re Application of: Ross A. Caputo *et al.*
Serial No. 09/901,389

Filed: July 9, 2001

For: APPARATUS FOR TESTING STERILIZATION METHODS AND
MATERIALS

Enclosed:

1. Response to Office Action Under 37 CFR § 1.116 Including Amendment with Certificate of Mailing (22 pp. including duplicate page 2); and
2. Return postcard.

KINDLY DATE STAMP AND RETURN TO
ACKNOWLEDGE RECEIPT

CMA:srb ✓





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 02/08/2006
BRYAN CAVE LLP
1290 AVENUE OF THE AMERICAS, 33RD FLOOR
New York, NY 10104
SPG

C41473/124196
PSZ-
FEB 14
Docketed-
Jesse Lee Lee 5/8/06

EXAMINER	
CHORBAJI, MONZER R	
ART UNIT	PAPER NUMBER

1744
DATE MAILED: 02/08/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,389	07/09/2001	Ross A. Caputo	41473/124196	4730

TITLE OF INVENTION: APPARATUS FOR TESTING STERILIZATION METHODS AND MATERIALS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$300	\$1700	05/08/2006

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.